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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,348	10/14/2003	Dale W. Malik	190250-1330	7196
38823 7590 03/31/2008 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/ AT&T Delaware Intellectual Property, Inc. 600 GALLERIA PARKWAY, S.E. SUITE 1500 ATLANTA, GA 30339-5994				
EXAMINER				
HUSSAIN, TAUQIR				
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2152				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/686,348

**Applicant(s)**

MALIK, DALE W.

**Examiner**

TAUQIR HUSSAIN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date 12/20/2007, 03/14/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to amendment /reconsideration filed on 01/25/2008, the amendment/reconsideration has been considered. Claims 2-4 have been amended, Claims 1-22 are pending for examination, the rejection cited as stated below.

### ***Response to Arguments***

2. Applicant's arguments, see Remarks, filed 01/25/2008, with respect to the rejection(s) of claim(s) 1-22 under 35 U.S.C 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Fostick et al (Pub No.: US 2002/0187794 A1).

3. Claim rejection under 35 U.S.C 112 second paragraphs is maintained as applicant arguments are not persuasive. In most recent remarks applicant cited that claim 1 does not include an element of sending the IM message to the second recipient, however in most recent sets of claim dated 12/21/2007, Claim 1 recites, "send the instant message to a second recipient" in lines 8-9. which implies sender is sending the message to second recipient, however it is not clear how the origin of Instant message is indicated by the "first recipient"?, therefore applicant is required to provide more clarification for the above issue.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. As to claims 10-18 are rejected under 35, U.S.C 101. In the light of specification on page 48, applicant has provided that applicant intends the medium to include transmission media, propagation medium, infrared etc. as such claim is drawn to a form of signal and light waves. Carrier waves or signal does not fall into one of the four categories of invention and therefore, claims 10-17 are not statutory. Signal is not a series of steps or acts and thus is not a process. Signal is not a physical article or object and such is not a machine or manufacture. Signal is not a combination of substances and therefore, not a composition of matter and further merely using paper to store information is also non-statutory category.

6. Claim 19 is rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter. As per claim 19, merely claiming as means for where the means is implemented in software representing a computer listing *per se*, non-functional descriptive material, and is not statutory because it is not a physical "thing" nor a statutory process, as there are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer program's functionality to be realized. Since a program itself is not a process, without the computer-readable medium needed to realize the computer

program's functionality. In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus statutory. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP 2106(IV)(B)(1)(a).

In Specification of the instant application describes that the present invention is within the scope of and can be implemented as software, thereby rendering the "means for" language in claim 19 as computer software. *In re Donaldson Co.*, 16F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), decided that

The "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure if disclosed in the specification corresponding to such language when rendering a patentability determination. See MPEP 2181 also. Therefore, giving the claims their broadest reasonable interpretation, while keeping the structure disclosed in the specification in mind, one of ordinary skill in the art would construe claim 19 as representing a computer program per se.

7. Claims 20-22 are rejected under 35 U.S.C 101 because claims is directed to logical component without associating any hardware and therefore, can be interpret as software modules or components. Therefore, giving the claims their broadest reasonable interpretation, while keeping the structure disclosed in the specification in

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mind, one of ordinary skill in the art would construe claims 20-22 as representing a computer program per se.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant is claiming mean plus function without disclosing/mentioning the details of specific mean (whether mean are associated with hardware or software or combination thereof) in any embodiments of the specification.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3, 5, 9-12, 14, 18-20 and 22 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Lee in views of Fostick et al (Pub No.: US 2002/0187794 A1), hereinafter Fostick.

11. As to claims 1 and 10, Lee discloses, receiving an instant messaging (IM) message from a sender to a first recipient (Lee, [0057, lines 1-4], where Instant Message is sent to a user who could be the first user to receive the IM message);

waiting a predefined time interval for an input from the first recipient, the input being responsive to the IM message (Lee, [0060, lines 3-5], where predetermined time interval is disclosed);

determining whether input from the first recipient is received during the predetermined time interval (Lee, [0060, lines 5-7], where agent determines if the if time is exceeded for response); and

in response to determining that no input from the first recipient is received during the predetermined time interval (Lee, [0060, lines 5-7], where agent determines if the time is exceeded for response).

Lee however is silent on disclosing explicitly, prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.

However, Fostick discloses, prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender (Fostick, [0040, lines 8-12], where ARMS stores all the user messages and if message does not get delivered the user, message is sent to second device e.g.

cell phone, pager etc. and further header information will indicate the message generating source).

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Lee with the instant messaging concepts of Fostick a system and method thereby extend the functionality and power of the SMS Center (hereinafter "SMSC) to incorporate email-type automatic replies, forwarding, filtering, saving and deleting of SMS messages on wireless handsets and other communication devices.

12. As to claims 5 and 14, Lee and Fostick disclose the invention substantially as independent claims 1 and 10 above, including, receiving an instant messaging (IM) message from a first sender to a recipient (Lee, [0057, lines 1-4], where Instant Message is sent to a user who could be the first user to receive the IM message);

determining whether input from the recipient is received during a predetermined time interval (Lee, [0060, lines 5-7], where agent determines if the if time is exceeded for response);

in response to determining that no input is received during the predetermined time interval (Lee, [0060, lines 5-7], where it is established that agent determines if the time is exceeded for response) determining whether the recipient is engaged in an IM chat session with a second sender (Lee, [0048, lines 3-7], where invitee/recipient has the status indicator that he will not attend or will attend or busy with other meetings, since it is well known in the art to that status can be customize as per user preferences,



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therefore user can select the status option to display as busy chatting with 2<sup>nd</sup> or 3<sup>rd</sup> user); and

in response to determining that the recipient is engaged in an IM chat session with the second sender, replying to the IM message in response to determining that the recipient is engaged in the IM chat session with the second sender (Lee, [0048, lines 3-7], where invitee/recipient has the status indicator that he will not attend or will attend or busy with other meetings, since it is well known in the art to that status can be customize as per user preferences, therefore user can select the status option to display as busy chatting with 2<sup>nd</sup> or 3<sup>rd</sup> user), prompting the sender to send the instant message to a second recipient and indicating, by the first recipient, that the IM message originated from the sender (Fostick, [0040, lines 8-12], where ARMS stores all the user messages and if message does not get delivered the user, message is sent to second device e.g. cell phone, pager etc. and further header information will indicate the message generating source).

13. As to claim 19 and 20 are rejected for the same rationale as applied to claim 1, 5, 10 and 14 above.

14. As to claim 22, Lee and Fostick disclose the invention substantially as in parent claim 20, including, message-generation logic configured to generate a message, the message being indicative of the recipient's unavailability to engage in an IM chat session (Lee, [0048, lines 3-7], where status indicator is indicative of the recipient's unavailability to engage in an IM chat session).

15. As to claims 2 and 11, Lee and Fostick disclose the invention substantially as in parent claims 1 and 10 above, including, providing a message indicating the recipient's unavailability to engage in an IM chat session (Lee, [0045, lines 8-10], where displaying status of user being taking a vacation day is indication that user's unavailability to chat on that particular day).

16. As to claim 9 and 18 are rejected for the same rationale as applied to claims 2 and 11.

17. As to claims 3 and 12, Lee and Fostick disclose the invention substantially as in parent claims 1 and 10 above, including, providing a message requesting the sender to wait for a predetermined time period (Fostick, [0007, lines 13-15], where time limited delay of message delivery is disclosed).

18. Claims 4, 8, 13 and 17 are rejected under 35 U.S.C 103 (a) as being unpatentable over Lee and Fostick in view of Murphy et al. (Pub. No.: US 2007/0274497 A1), hereinafter "Murphy".

19. As to claims 4 and 13, Lee and Fostick disclose, the invention substantially as in parent claim 1 and 10. Lee and Fostick however are silent on disclosing, "Periodically providing messages" or "the messages periodically being provided at predefined time intervals" or "each message indicating the recipient's unavailability to engage in an IM chat session during the corresponding predefined time interval".

Periodically providing messages (Murphy, [0066], where message is queried periodically for presence detection to call destination computer system), the messages periodically being provided at predefined time intervals (Murphy, where message is queried periodically for presence information at predefined time i.e. every 15 sec), each message indicating the recipient's unavailability to engage in an IM chat session during the corresponding predefined time interval (Murphy, [0066], where status and user's availability is determined by status determination).

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to combine the teachings of Lee and Fostick with the collaborated system (call and presence detection) of Murphy in order to provide an electronic communication associated with the phone call is sent across the network to the one or more external online service provider systems conditioned on whether the identity is determined to be available to receive the electronic communication.

20. As to claims 8 and 17 are rejected for the same rationale as applied to claims 4 and 13 above.

21. Claims 6-7 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee and Fostick in view of Manabe.

22. As to claims 6 and 15, Lee and Fostick disclose the invention substantially as in parent claims 5 and 14 above. Lee and Fostick however, are silent on disclosing explicitly, waiting a predefined time interval prior to replying to the IM message. Manabe, however discloses, waiting a predefined time interval prior to replying to the IM

message (Manabe, Abstract, where detection of a keystroke or keyword, judges user status based on the status of the user terminal means when recipient replies to a message, a sender can see the status of the recipient as recipient is writing, therefore, sender can wait until recipient finish writing to conduct a smooth conversation in real time).

Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Lee and Fostick with the teachings of Manabe in order to provide a real-time status of a user called be a keyword is reported to a users engaged in IM chat session.

23. As to claims 7 and 16, Lee, Fostick and Manabe disclose the invention substantially as in parent claims, 5 and 14, including, indicating to the first sender that the recipient is engaged in an IM chat session with the second sender (Manabe, Col.1, lines 55-60, where another application could be a chat session with second user).

24. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee and Fostick in view of Glasser.

25. As to claim 21, Lee and Fostick disclose the invention substantially as in parent claim 20. Lee and Fostick are however silent on, a timer configured to track elapsed time from a receiving of an M message. Glasser however discloses a timer configured to track elapsed time from a receiving of an M message (Glasser, Abstract, where each message is measure by a timer).

Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Lee and Fostick with the teachings of Manabe in order to provide a system for promoting smooth communications in a chat system. A keyword list 3 stores keywords. A keyword-detection module 2 detects the sending of any keyword from another user terminal on any channel. A status-detection section 4, in response to the detection of a keyword, judges user status based on the status of the user terminal.

26. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references, as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAUQIR HUSSAIN whose telephone number is (571)270-1247. The examiner can normally be reached on 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571 272 3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/T. H. /

Examiner, Art Unit 2152

/Bunjod Jaroenchorwanit/

Supervisory Patent Examiner, Art Unit 2152